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1 UNITED STATES PATENT AND TRADEMARK OFFICE
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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* ROBERT JOSEPH ANGEN and JOHN GARRETT PENN II
9

10 Appeal 2009-010449
11 Application 10/813,606
12 Technology Center 3600
13

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15 Decided: March 4, 2010
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18 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
19 JOSEPH A. FISCHETTI, *Administrative Patent Judges*.
20 FETTING, *Administrative Patent Judge*.
21

22 DECISION ON APPEAL

1

2 1. A display system comprising:

3 [1] a shelf assembly having at least a first and second side;

4 [2] one or more wall mounting assemblies for mounting to a
5 wall and

6 comprising a slotting mechanism

7 for removably mounting a shelf mount assembly,

8 wherein the shelf assembly may be removed

9 without removing a wall mount

10 attachment mechanism from the one

11 or more wall mounting assemblies;

12 [3] a shelf mount assembly

13 for mounting to one or more wall mounting assemblies

14 through the slotting mechanism and

15 removably mounting the shelf assembly; and

16 [4] one or more display object mounting assemblies,

17 wherein each of the one or more display object mounting
18 assemblies

19 removably and rotatably mount a display object to
20 the first side of the shelf assembly,

21 such that the display object is rotatable about an
22 axis for display purposes and

23 is removable from the shelf assembly;

24 [5] wherein the shelf assembly enables a person

25 to view at least a majority of the display object

26 from the second side of the shelf assembly.

THE REJECTIONS

The Examiner relies upon the following prior art:

Gregory	US 606,889	Jul. 5, 1898
Winter	US D305,190	Dec. 26, 1989
Peters	US 5,165,538	Nov. 24, 1992
Sickels	US 6,467,745 B1	Oct. 22, 2002

Claims 1 and 5-7 stand rejected under 35 U.S.C. § 102(b) as anticipated by Gregory.

Claims 2, 3, 10-12, and 14-16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Gregory and Winter.

Claims 8, 9, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Gregory, Winter, and Peters.

Claims 4 and 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Gregory, Winter, and Sickels.

ISSUES

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1 and 5-7 under 35 U.S.C. § 102(b) as anticipated by Gregory turns on whether Gregory mounts its shelf to the desk or wall mount with a shelf mount.

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 2, 3, 10-12, and 14-16 under 35 U.S.C. § 103(a) as unpatentable over Gregory and Winter turns on

whether Winter's use of transparent material is predictable by Gregory's shelf.

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 8, 9, 17, and 18 under 35 U.S.C. § 103(a) as unpatentable over Gregory, Winter, and Peters turns on whether Peters' use of transparent mount is predictable by Gregory's shelf.

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 4 and 13 under 35 U.S.C. § 103(a) as unpatentable over Gregory, Winter, and Sickels turns on whether Sickels' use of a vertical shelf is predictable by Gregory's shelf.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to the Prior Art

Gregory

01. Gregory is directed to a swinging support for mounting equipment such as a typewriter. Gregory 1:10-14.
02. Gregory describes a plate (Fig. 1:A) for securing the entire mechanism vertically by means of fasteners through holes (Fig. 3:B). Gregory 1:37-47.
03. Gregory describes vertical holes or slots in the hinged lugs (Fig. 1:C & D) that are attached to the plate (Fig. 1:A). Gregory 1:37-47.

04. Gregory describes a hinge pin (Fig. 1:H) attached to the upper center (Fig. 1:G) on shelf (Fig. 1:F) and thumb screw (Fig. 1:I) for attaching to the lower center (Fig. 1:G) on the shelf (Fig. 1:F).

The hinge pin and thumbscrew mount the shelf to the plate through the slots in the hinged lugs (Fig. 1:C & D). Gregory 1:48-60.

05. Gregory describes a combination of a disk (Fig. 1:N) and thumb nut (Fig. 1:O) allowing whatever is attached to rotate. Gregory has two holes (Fig. 1:P) to secure something to the disk.

Winter

06. Winter is a design patent directed to a display shelf (Winter Cover page: Description).

07. Winter Fig. 1 portrays a shelf made of transparent material that is offset at an acute angle.

Peters

08. Peters is directed to a device to hold souvenir balls. Peters 1:6-7.

09. Peters describes using a lower portion made of transparent material to support a display object (baseball in Peters). Peters 2:26-36.

Sickels

10. Sickels is directed to a mounting bracket. Sickels 1:7-9.

11. Sickels describes mounting brackets for adjustably supporting objects on walls and other support surfaces are well known.

Sickels 1:12-14.

12. Sickels shows a mounting bracket in which the support surface is parallel to the wall. (Sickels Fig. 1:24).

PRINCIPLES OF LAW

Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: “[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383 U.S. at 17. *See also KSR*, 550 U.S. at 406. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416.

ANALYSIS

Claims 1 and 5-7 rejected under 35 U.S.C. § 102(b) as anticipated by Gregory.

The Appellants contend that Gregory fastens its shelf to a desk rather than a wall; Gregory does not describe a slotting mechanism; and Gregory directly attaches the shelf assembly to the wall mount assembly. Appeal Br. 9.

As to Gregory's describing its plate as mounting to the side of a desk, claim 1 recites a display system and is therefore it is defined by its structural limitations and not by how it is used. *In re Schreiber*, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997); *see also In re Swinehart*, 439 F.2d 210, 212-13 (CCPA 1971);

Thus, the phrase “for mounting to a wall” in limitation [2] requires that the device be structurally capable of wall mount. Gregory describes a plate for securing the entire mechanism vertically by means of fasteners through holes. FF 02. Clearly, fasteners such as screws, can mount Gregory’s plate to a wall as well as to a desk.

1 As to a slotting mechanism, Gregory describes vertical holes or slots in
2 the hinged lugs that are attached to the plate. FF 03. The Appellants argue
3 that the necessity of a thumb screw obviates such a slotting mechanism.
4 Reply Br. 4. This argument was not presented in the original Appeal Brief.

5 However, even taking the argument on its face, the argument ignores the
6 lower hole or slot that the thumb screw passes through. FF 04. The only
7 structural requirement of the slotting mechanism is that it allow the shelf
8 assembly to be removed without removing a wall mount attachment
9 mechanism from the wall mounting assembly. Clearly the screws
10 (corresponding to the wall mount attachment mechanism) that attach
11 Gregory's plate to a desk (or wall) do not have to be removed for Gregory's
12 shelf to be removed from the plate. All that is required is to unscrew the
13 thumb screw and lift the shelf to clear the hinge pin.

14 Finally we come to the third argument, again repeated in the Reply Brief
15 at 3-4. This argument contends that Gregory's shelf mount assembly is
16 inseparable from Gregory's shelf assembly. Appeal Br. 9; Reply Br. 3. This
17 argument is not commensurate with the scope of the claims. Limitation [3]
18 requires that the shelf mount assembly be mountable to the wall mounting
19 assembly through the slotting mechanism and allows the shelf assembly to
20 be removably mounted. There is no requirement that the shelf and shelf
21 mount be separable. To the extent the Appellants are arguing that the last
22 phrase in limitation [3] poses such a requirement, that phrase does not
23 specify the structure from which the shelf assembly is to be removed, so the
24 property of Gregory's shelf being removable from the plate (corresponding
25 to the claimed wall mount) reads on this phrase in the limitation.

As to claims 5, 6, and 7, separately argued (Appeal Br. 10-11), these claims require that the display be capable of mounting a model car (claim 5); a packaging attachment mechanism to secure a display object to a retrofit bracket, the retrofit bracket being rotatably and removably secured to the shelf (claim 6); and the retrofit bracket having one side capable of being secured to a display object and a second side being secured to the shelf assembly (claim 7). As the Examiner found (Ans. 3), a model car can readily be mounted to Gregory's disk via its mounting holes (Gregory Fig 1:N); Gregory's disk (corresponding to the claimed retrofit bracket) is rotatably and removably secured to the shelf with a thumb nut (corresponding to the claimed packaging attachment mechanism); and Gregory's disk has one top side to which something to be displayed may be secured with the two mounting holes and the other side of the disk is secured to the shelf. (FF 05).

Claims 2, 3, 10-12, and 14-16 rejected under 35 U.S.C. § 103(a) as unpatentable over Gregory and Winter.

Claim 2 further requires that the shelf be transparent and claim 3 that the shelf be at an acute angle. The Examiner applied Winter for these limitations. Ans. 4-5. The Appellants again argue that these claims are patentable for incorporating the limitations of parent claim 1 and also that Winter does not describe the transparent material and acute angle. The Appellants also argue a lack of motivation in the prior art. Appeal Br. 11-12. We disagree with the Appellants.

Winter Fig. 1 portrays a display shelf made of transparent material that is offset at an acute angle. FF 06 & 07. As to motivation,

[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents. The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way. In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends.

KSR, 550 U.S. at 419.

The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *id.* 550 U.S. at 416. Where, as here “[an application] claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result,” *Id.* 550 U.S. at 416 (citing *United States v. Adams*, 383 U.S. 50-51 (1966)). The Examiner articulated reasoning with rational underpinning that one of ordinary skill would have modified Gregory with transparent material to focus visual attention (Final Rej. 4) and with an acute angle to protect against having a display object fall to the floor if detached (Ans. 9.)

Our analysis of why the parent claim is unpatentable is shown *supra*. Claims 10-12 and 14-16 are to various combinations of claims 1-3 and 5-7. The arguments are similar to those presented for claims 1-3 and 5-7 and we find them equally unpersuasive here.

Claims 8, 9, 17, and 18 rejected under 35 U.S.C. § 103(a) as unpatentable over Gregory, Winter, and Peters.

Claim 8 further requires that the retrofit bracket enable a person to view at least a majority of the display object's surface through the retrofit bracket

1 and claim 9 that retrofit bracket be transparent. The Examiner applied
2 Winter for these limitations. Ans. 5-6. The Appellants again argue that
3 these claims are patentable for incorporating the limitations of parent claim 1
4 and also that Winter does not describe the transparent material and viewing
5 enablement. The Appellants also argue a lack of motivation in the prior art.
6 Appeal Br. 18-19. We disagree with the Appellants.

7 Peters describes using a lower portion made of transparent material to
8 support a display object. FF 09. This lower portion corresponds to the
9 claimed retrofit bracket, because Peters' lower portion secures its display
10 object. Because the lower portion is transparent, it enables a person to view
11 at least a majority of the display object's surface through the lower portion.

12 The Examiner repeated the rationale from claims 2 and 3 for modifying
13 Gregory with transparent material. Ans. 12-13.

14 Claims 17 and 18 are essentially the same as claims 8 and 9. The
15 arguments are similar to those presented for claims 8 and 9 and we find them
16 equally unpersuasive here.

17 *Claims 4 and 13 rejected under 35 U.S.C. § 103(a) as*
18 *unpatentable over Gregory, Winter, and Sickels.*

19 Claim 4 further requires mounting the shelf assembly parallel to the
20 wall. The Examiner applied Sickels for this limitation. Ans. 6. The
21 Appellants again argue that these claims are patentable for incorporating the
22 limitations of parent claim 1 and also that Sickels does not describe the
23 mount parallel to the wall. The Appellants also argue a lack of motivation in
24 the prior art. Appeal Br. 20-21. We disagree with the Appellants.

Sickels shows a mounting bracket in which the support surface is parallel to the wall. FF 12. Sickels also describes mounting brackets for adjustably supporting objects on walls and other support surfaces as being well known. Thus, Sickels does no more than demonstrate a way of providing a well known mount.

The Examiner articulated a rationale with rational underpinning for modifying Gregory with a bracket that can be moved to any vertical angle for the purpose of accommodating the decreasing distance from the mounting surface as Gregory's shelf is swung about its pivots. Ans. 14.

Claim 13 is essentially the same as claim 4. The arguments are similar to those presented for claim 4 and we find them equally unpersuasive here.

CONCLUSIONS OF LAW

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 1 and 5-7 under 35 U.S.C. § 102(b) as anticipated by Gregory.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 2, 3, 10-12, and 14-16 under 35 U.S.C. § 103(a) as unpatentable over Gregory and Winter.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 8, 9, 17, and 18 under 35 U.S.C. § 103(a) as unpatentable over Gregory, Winter, and Peters.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 4 and 13 under 35 U.S.C. § 103(a) as unpatentable over Gregory, Winter, and Sickels.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 1 and 5-7 under 35 U.S.C. § 102(b) as anticipated by Gregory is sustained.
- The rejection of claims 2, 3, 10-12, and 14-16 under 35 U.S.C. § 103(a) as unpatentable over Gregory and Winter is sustained.
- The rejection of claims 8, 9, 17, and 18 under 35 U.S.C. § 103(a) as unpatentable over Gregory, Winter, and Peters is sustained.
- The rejection of claims 4 and 13 under 35 U.S.C. § 103(a) as unpatentable over Gregory, Winter, and Sickels is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

Vsh

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